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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,547	01/03/2001	Alain T. Rappaport	4239P003	3731

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/754,547

Applicant(s)

RAPPAPORT

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-22 and 24-55 is/are pending in the application.
- 4a) Of the above claim(s) 21-22, 24-37, and 50-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-20, 38-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Notice to Applicant

1. This communication is in response to the Applicant's response filed 7/22/04.
Claims 1-7, 10-22, and 24-55 are pending. Claims 8, 9, 23, and 56 have been cancelled.
Claims 21-22, 24-37, and 50-55 have been withdrawn from consideration.

Election/Restrictions

2. Applicant's election of Group I in the reply filed on 7/22/04 is acknowledged.
Because applicant did not distinctly and specifically point out any errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Drawings

3. The drawings were received on 7/22/04. These drawings are acceptable.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 10-15, and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

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For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of merely obtaining information about a medical procedure performed for a patient regarding and performing various queries to does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention/method generates a set of queries and one or more documents for obtaining patient information, and is therefore considered useful, tangible, and concrete.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter. The deficiencies in the present claim language may be overcome by expressly stating in the body of the claims the use of technology, such as a *computer* processor and/or a *computer* database.

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Claims 2-7, 10-15, and 20 likewise do not incorporate technological arts in the body of the claim are also rejected.

The rejection of claim 42 under 35 U.S.C. 101 is hereby withdrawn due to the response filed 7/22/04.

The rejection of claims 21-32 and 55 under 35 U.S.C. 101 are hereby rendered moot due to the response/election filed 7/22/04.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites "[t]he method of claim 8..." However, claim 8 has been cancelled, and therefore, the chain of dependency is for the present claim is unclear to the Examiner. For examination purposes, the Examiner will interpret the claim as being directly dependent from claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1,6-7,10-15,17-20,and 38-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Bessette (US Patent No. 6,263,330).

In reference to claim 1, Bessette teaches a data searching method comprising:

- receiving information about a medical procedure performed for patient based upon a request from a healthcare provider (Figure 4, 9)
- querying to retrieve a list of data sources data sources from at least one database based on received information (about the medical procedure) (Figure 9; col. 3, line 41-col. 4, line 52; col. 11, lines 11-67;col. 15, lines 25-col. 16, line 29)
- generating at least one document containing the list of data sources retrieved from the database, (col. 13, lines 1-43) wherein performing the query function comprises:
 - o generating a set of queries containing query criteria based on the received information about medical procedure; and (Figures 2,4,6,8-9; col. 12, lines 1-67; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)
 - o executing the set of queries to retrieve from the database the list of data sources matching the query criteria, wherein generating the set of queries comprises selecting a set of existing queries that correspond to the received information about the medical procedure. (Figures 2,4,6,8-9; col. 11, lines 11-56; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)

In reference to claims 6-7, Bessette teaches a data retrieval method wherein the data source is referenced by an address and this address comprises a URL (i.e. a web address) (column 13, lines 1-38)

In reference to claims 10-15, Bessette teaches a method wherein generating the set of queries comprises constructing a set of queries based on the information received about the medical procedure. (col. 13, lines 1-38; col. 15, lines 52-67) Bessette further discloses determining at least one medical procedure identifier from information received. (col. 15, lines 4-24; Figure 6C; Figure 10 e.g. links to antecedents/surgical history, previous procedures)

In reference to claims 17-19, Bessette teaches a method that operates via the Internet (col. 6, line 64-col 7, line 21) and wherein a healthcare provider (i.e. the healthcare facility) can provide feedback on information contained in the retrieved documents (col. 14, lines 39-col. 15, line 3).

In reference to claim 20, Bessette teaches a method wherein the query criteria include contextual information applicable to the information received. (col. 7, line 52-col. 8, line 4; col. 11, lines 25-67; col. 15, lines 4-67)

In reference to claim 38, Bessette teaches a system comprising:

- a first database to store multiple lists of content links, each list corresponding to a specific medical procedure code; and (col. 8, line 52-col. 9, line 36; col. 13, lines 39-col. 14, line 21; col. 15, lines 4-24; col. 16, lines 5-29; Figures 3,5)

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- a first server to receive information about medical procedure from at least one source, said information about medical procedure including at least one procedure code, the first server to retrieve from the first database at least one list of content links based upon the at least one code received, (col. 8, line 52-col. 9, line 36; col. 13, lines 39-col. 14, line 21; col. 15, lines 4-24; col. 16, lines 5-29), the first server to generate at least one document containing the at least one list of content links retrieved from the first database, wherein the first server is to select a set of existing queries that correspond to information about the medical procedure to retrieve from the first database the at least one list of content links. (col. 15, line 52-col. 16, line 29; Figures 3,5)

In reference to claim 39, Bessette teaches a system wherein the at least one document generated is stored in a second database. (col. 13, lines 4-38; col. 15, lines 4-46)

In reference to claim 40, Bessette teaches a system that operates via the Internet (col. 6, line 64-col 7, line 21) and wherein a healthcare provider (i.e. the healthcare facility) can provide feedback on information contained in the retrieved documents (col. 14, lines 39-col. 15, line 3).

In reference to claim 41, Bessette teaches a system wherein the computer network is the Internet. (col. 6, line 64-col. 7, line 9)

In reference to claim 42, Bessette teaches a system wherein the first server includes a machine-readable medium comprising instructions which, when executed by a machine, cause the machine to perform operations, the instructions to comprise:

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- logic to receive the information about the medical procedure from the at least one source; (Figures 6; col. 4, lines 18-34, col. 7, lines 22-51; col. 14, line 40-col. 15, line 3)
- logic to generate a set of queries based upon the at least one definition that corresponds to the at least one procedure code received; and (col. 13, lines 23-col. 14, line 20; col. 15, lines 4-67)
- logic to execute the set of queries to retrieve from a first database the at least one list of content links that corresponds to the set of queries. (col. 13, lines 23-col. 14, line 20; col. 15, lines 4-67; Figure 10)

In reference to claim 43, Bessette teaches a system wherein each list of content links stored is identified using a set of queries generated from at least one definition associated with a respective procedure code. (Figures 6,10; col. 13, lines 1-col. 14, line 21)

In reference to claims 44-45, see Bessette: col. 11, line 40-56; col. 13, lines 23-col. 14, line 21; col. 15, line 4-col. 16, line 29.

In reference to claims 46, the present claim repeats the subject matter of claim 1, as computer readable-medium embodying instructions to perform the method recited in claim 1. Insofar as the method of claim 1 has been shown to be computer-implemented in the rejection of claim 1 above, the limitations of claim 46 are addressed by the rejection of claim 1, and incorporated herein.

In reference to claim 47, Bessette discloses that the medical procedure information comprises at least one medical procedure code indicating the procedure

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performed for the patient. (col. 15, line 4-24; Figures 6A-6C: antecedents; previously performed procedures)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-5, 16, and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette in view of Evans (US Patent No. 5,924,074).

In reference to claims 2-5, Bessette teaches a medical retrieval method that incorporates the use of codes to identify relevant medical data (col. 13, lines 52-56; col. 14, lines 10-21). However, Bessette does not specifically disclose the use of ICD or CPT codes for retrieving relevant medical data using various health codes. Evans teaches a data retrieval system/method wherein receiving data in the patient's records comprises accessing procedure codes or diagnosis codes for procedures/diagnoses that the patient has undergone/received and wherein the codes are CPT or ICD codes. (column 9, lines 4-7, figure 20; column 11, lines 14-27). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to combine the teachings of Bessette with the teachings of Evans. As suggested by Evans, one would have been motivated to include this feature to provide enhanced analysis of patient data

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and to facilitate a treating healthcare provider's access to a wide range of critical medical data relating to his/her patients. (col. 2, lines 45-64)

In reference to claims 16, Bessette teaches different methods of querying and retrieving data regarding patient procedures based upon the user's query terms and related concepts. (col. 13, lines 1-col 14, lines 21) Bessette further discloses providing information on a medical procedure identifier for patients (Figure 6C-e.g. antecedents, previous procedures), but does not expressly disclose determining additional procedure identifiers that are equivalent to procedure identifiers provided (i.e. by the user). Evans teaches a system/method that provides equivalent procedure identifiers (e.g. procedure descriptions) for a querying healthcare provider. (column 11, lines 10-30; Figures 19-20—Allergy Skin Tests). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Bessette with the teaching of Evans to determine equivalent procedure identifiers for received procedure information (i.e. received information on procedures). As suggested by Evans, one would have been motivated to include this feature to increase accuracy in selecting information regarding diagnosis and appropriate treatments for patients. (col. 11, lines 37-60)

In reference to claim 48, Bessette teaches a medical retrieval method that incorporates the use of codes to identify relevant medical data (col. 13, lines 52-56; col. 14, lines 10-21) to provide information on relevant medical procedures performed on a patient. However, Bessette does not specifically disclose the use of ICD or CPT codes for retrieving relevant medical data using various health codes. Evans teaches a data

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retrieval system/method wherein receiving data in the patient's records comprises accessing procedure codes or diagnosis codes for procedures/diagnoses that the patient has undergone/received and wherein the codes are CPT or ICD codes. (column 9, lines 4-7, figure 20; column 11, lines 14-27). At the time of the Applicant's invention, it would have been obvious to one of ordinary in the art to combine the teachings of Bessette with the teachings of Evans. As suggested by Evans, one would have been motivated to include this feature to provide enhanced analysis of patient data and to facilitate a treating healthcare provider's access to a wide range of critical medical data relating to his/her patients. (col. 2, lines 45-64)

In reference to claim 49, Bessette teaches the machine-readable medium of claim 48 wherein performing the query function comprises:

- generating a set of queries containing query criteria based on the received information about medical procedure; and (Figures 2,4,6,8-9; col. 12, lines 1-67; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)
- executing the set of queries to retrieve from the at least one database the list of data sources matching the query criteria. (Figures 2,4,6,8-9; col. 11, lines 11-56; col. 13, lines 1-43; col. 14, line 40-col. 15, line 3)

Response to Arguments

Applicant's arguments with respect to claims 1-7, 10-20, and 38-49 have been considered but are moot in view of the new ground(s) of rejection. The grounds of rejection have been altered and/or additional citations and explanations have been

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added to the provided to the previous rejection(s) to address the additional limitations of the claims in the art rejection provided in the present Office Action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Neuron Data website printout packet discloses a product for physician to search/query patient parameters to determine appropriate dosages.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703)305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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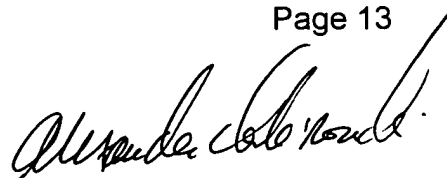
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October 18, 2004

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A handwritten signature in black ink, appearing to read "Alexander Kalinowski".

ALEXANDER KALINOWSKI
PRIMARY EXAMINER